



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/781,615	02/12/2001	Iwao Hatanaka	[CHA9-99-013]	9504

7590 10/04/2004

ATTEN: MICHAEL HOFFMAN
HOFFMAN, WARNICK & D' ALESSANDRO LLP
3 E COMM SQUARE
ALBANY, NY 12207

EXAMINER

WOOD, WILLIAM H

ART UNIT PAPER NUMBER

2124

DATE MAILED: 10/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/781,615

Applicant(s)

HATANAKA, IWA0

Examiner

William H. Wood

Art Unit

2124

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Claims 1-8 are pending and have been examined.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

2. Claims 1, 3 and 5 are rejected under 35 U.S.C. 102(a) as being anticipated by **Seacord et al.**, “A Survey of Black-Box Modernization Approaches for Information Systems”.

Claim 1

Seacord disclosed a system for integrating a legacy application into a distributed data processing environment (*Abstract, page 173*), the system comprising:

- ♦ a legacy application located at a server coupled to a network (*page 180, section 3.3.3, first three paragraphs, left column*);
- ♦ an Enterprise JavaBean (EJB) wrapper surrounding the legacy application (*page 180, last paragraph, left column; page 181, figure 5*), said wrapper including an interface which allows for the distributed processing of the legacy application by a plurality of different processors over the network (*page 180, left column, three bulleted items, note server and thus multiple processors*), whereby the EJB

Art Unit: 2124

interface allows for the distributed processing and the legacy application retains its conventional processing (*page 180, first paragraph, right column; facilitated by wrapping*).

Claim 3

Seacord disclosed a method of integrating a legacy application into a distributed data processing environment (*Abstract, page 173*), the steps of the method comprising:

- ♦ analyzing a legacy application to separate its function into components (*page 180, left column, last paragraph and right column, first paragraph*);
- ♦ distributing the components to different servers in the distributed data processing environment (*page 180, left column, bulleted items; distributed*);
- ♦ providing each component with an EJB interface (*page 180, left column, last paragraph and right column, first paragraph*);
- ♦ providing an index to the components and the interface (*page 180, right column, second paragraph; single access point to all other points*).

Claim 5

Seacord disclosed the method of integrating a legacy application into a distributed data processing environment including the steps of Claim 3 and

Art Unit: 2124

further including the step of using a shared library accessing a component bean and a library of export symbols (*page 180, right column, second paragraph; single access point to all other points, provides library/index of exports*).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 2 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Seacord** et al., "A Survey of Black-Box Modernization Approaches for Information Systems" in view of **Sintas**, Tony, "Does Java pass by reference or pass by value?".

Claim 2

Seacord did not explicitly state the system for integrating a legacy application of claim 1 wherein the system is configured such that data can be passed by value rather than by reference. **Sintes** demonstrated that it was known at the time of invention to provide structure to for "pass-by-value" in Java (first page, first two paragraphs of the Answer section). It would have been obvious to one of ordinary skill in the art at the time of invention to implement the Enterprise JavaBean (EJB) wrapping system of **Seacord** with "pass-by-value" of the Java

Art Unit: 2124

language as found in **Sintes** teaching. This implementation would have been obvious because one of ordinary skill in the art would be motivated by the natural implementation of Java and the commonality of its various aspects (EJB).

Claim 4

See claim 2 above.

5. Claims 6 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Seacord** et al., "A Survey of Black-Box Modernization Approaches for Information Systems" in view of "Dictionary of **Computing**".

Claims 6 and 8

The limitations of claims 6 and 8 correspond to the limitations of claims 3 and 5 and are rejected in the same manner. **Seacord** did not explicitly state a program for carrying out the operations. **Computing** demonstrated that it was known at the time of invention to make use of programs to produce a desired behavior (page 389). It would have been obvious to one of ordinary skill in the art at the time of invention to implement the legacy wrapping system of **Seacord** with a program to carry out the operations/actions as found in **Computing**'s teaching. This implementation would have been obvious because one of ordinary skill in the art would be motivated to automate actions in order to reduce burden on the implementers of the action.

Art Unit: 2124

6. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Seacord** et al., "A Survey of Black-Box Modernization Approaches for Information Systems" in view of "Dictionary of **Computing**" in further view of **Sintas**, Tony, "Does Java pass by reference or pass by value?".

Claim 7

In view of claim 6 and further in view of claim 4 above.

Response to Arguments

7. Applicant's arguments filed 24 June 2004 have been fully considered but they are not persuasive. Applicant argued: ¹⁾ **Seacord** failed to disclose *interface which allows for the distributed processing of the legacy application by a plurality of different processors over the network ...*; and ²⁾ **Seacord** failed to disclose *providing an index and using a shared library*. Upon review, Applicant's arguments are seen as incorrect.

First, **Seacord** demonstrates EJB distributed processing on page 180, third bulleted item, "Enterprise JavaBeans (EJB) is the Sun Microsystems solution for Java *server-side* computing". "Server" clearly indicates "distributed" and plurality of processors. Further reading of the entire document reveals the context of the internet, client-servers and networks.

Second, Applicant does not reveal how the cited portions of **Seacord** fail to disclose the claimed invention. Under the broadest reasonable interpretation, it is clear the "single access point" provides an index (page 180, right column,

Art Unit: 2124

second paragraph, "centralize all the communication knowledge", allowing all components of the legacy system to be accessed) and a shared library (page 180, right column, second paragraph, "centralize all the communication knowledge"; and "These beans forward requests to the legacy system using the single contact point").

Thus, having addressed all of Applicant's concerns, the above rejections are maintained. 35 U.S.C. § 112 first paragraph rejection of previous Office Action is withdrawn.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Art Unit: 2124

Correspondence Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William H. Wood whose telephone number is (703)305-3305. The examiner can normally be reached 7:30am - 5:00pm Monday thru Thursday and 7:30am - 4:00pm every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kakali Chaki can be reached on (703)305-9662. The fax phone numbers for the organization where this application or proceeding is assigned are (703)746-7239 for regular communications and (703)746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-3900.

William H. Wood
September 21, 2004

Kakali Chaki

**KAKALI CHAKI
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100**